

REMARKS

Claims 1-31 are pending. Claims 1-31 were rejected. Applicants respectfully request reconsideration in view of the following remarks.

Claims 1-31 were rejected under 35 U.S.C. 103(a) as being obvious over McGraw (USP 5,577,042) in view of Grant (USP 6,553,566). The Office Action acknowledges that McGraw does not describe embedding first compressed video data having a first compressed format in a transmission bitstream having a second compressed format. The Office Action relies on Grant to teach this omission.

Applicants respectfully traverse the rejection. The proposed combination uses references with opposing intent, contradicts several rules in the MPEP, and still fails to teach all limitations recited in the claims.

McGraw describes a method for broadcasting in a variety of formats.

Grant describes a receiver chip that censors content. Grant is upset that a small segment of the population dictates what the vast majority must view (see Background, col. 1, lines 12-34). His chip scrambles selected frames of video content, prior to display on a screen, which are deemed to contain objectionable material (frontal nudity, explicit depictions of sex acts, extreme violence, drug use, etc.).

First, the references diametrically oppose each other. The Examiner asserts it would be obvious to look to Grant to incorporate its teachings in McGraw's network device. Not according to the teachings of the references. McGraw and Grant provide conflicting systems. McGraw wants open broadcasting. Grant openly opposes and distrusts such broadcasters (see his Background) and censors objectionable content from such open broadcasters. More specifically, Grant sensors objectionable content at a receiver (a viewer) because the viewer cannot control what the broadcaster does. Grant assumes that a broadcaster transmits explicit material that opposes the moral interest of his viewer, and assumes that the viewer and broadcaster are not cooperating. As a result, Grant's solution is for his viewer to take matters into their own hands to censor such 'offensive' material at the receiver. Grant's solution dictates that the two systems DO NOT work together. One of skill in the art would NOT look to Grant (who opposes open

broadcasting) to modify McGraw. As states in the MPEP, "References Cannot be Combined Where the Reference Teaches Away from Their Combination" (MPEP 2145 X.D.2)

The combination violates another rule of the MPEP. McGraw's desire is: "A broadcast and presentation system for synthesis of diverse data transmission" (the very first line of the Abstract). McGraw's objects of the invention all point towards robust delivery of content. Grant's censorship system restricts data delivery. "The proposed modification cannot render the prior art unsatisfactory for its intended purpose" (MPEP 2143.01). Applying Grant's censorship to McGraw betrays the robust broadcasting intent of McGraw. The combination of these two references is thus improper.

MPEP 2143.01 also states that teachings of the references cannot conflict, which is apparent given the opposing desires of these two references. The references must teach a motivation to combine. In this case, the references repeatedly do the opposite.

The Office Action asserts on page 3 that "a skilled artisan would look to Grant to incorporate its teachings in McGraw's network device". Applicants respectfully disagree. Per above, this suggestion is opposed and not supported by the references. In addition, from a hardware perspective, Grant teaches a receiving censorship chip. This chip does not broadcast, and is not combinable with the broadcasting hardware of McGraw.

Moreover, despite the dubious combination, the references still fail to teach all limitations of the claims. Grant does not teach or suggest embedding first compressed video data having a first compressed format in a transmission bitstream having a second compressed format. Grant only describes a single compressed format for video data, the compressed video packet (CVP) embedded in video programming signals (Column 4, Lines 1-2). A second compressed format is not described. The latest Office Action asserts col. 5, lines 4-19 to teach this limitation. This portion of Grant teaches uncompressed video formats such as PAL, HDTV, etc. One of skill in the art is aware of the difference between compressed and uncompressed video formats. The former is used to efficiently transport data, the latter refers to an uncompressed video format used by a particular video device (such as HDTV for a big screen television). The two are not interchangeable; one of skill in the art would not use an uncompressed video format such as HDTV to transport data efficiently, and one does not teach another. The claimed elements remain untaught by both references.

For at least these reasons, Applicants respectfully submit that McGraw and Grant, either alone or in combination, do not teach or suggest independent claims 1, 18, 23, 30, and 31, and that the independent claims are allowable.

Dependent claims 2-17, 19-22, and 24-29 each depend either directly or indirectly from independent claims 1, 18 and 23 and are patentable over McGraw and Grant for at least the reasons set forth above with respect to the independent claims. For example, dependent claim 7 recites operations on four different compressed formats. McGraw and Grant, either alone or in combination, do not teach receiving and embedding four different compressed formats.

Applicants also note that the Office Action has failed to provide proper basis for rejecting claims 2, 5, 7-10, 20, 22, 24 and 25. No specific or meaningful portions of either reference have been illuminated to support rejection of these claims. The June 22, 2004 Office Action only points to two superceding paragraphs (pages 2-3) used to reject independent claims 1, 18, 23, 30, and 31. These two very brief paragraphs include no mention of particular limitations included in the dependent claims. For claim 7 for example, where in the prior art are the first, second, third and fourth compression formats described with respect to receiving and embedding as recited in the independent claims? Meaningful application of the references is missing. Any further re-application of the current rejection should remedy these omissions for each dependent claim.

Claim 6 is rejected were rejected under 35 U.S.C. 103(a) as being obvious over McGraw (USP 5,577,042) in view of Grant (USP 6,553,566) and in further view of Lankford (USP 5,467,139).

Claims 11-12, 21, and 29 were rejected under 35 U.S.C. 103(a) as being obvious over McGraw (USP 5,577,042) in view of Grant (USP 6,553,566) and in further view of Wee (USP 6,507,618).

Claims 6, 11-12, 21, and 29 each depend either directly or indirectly from independent claims 1, 18 and 23 and are patentable over McGraw and Grant for at least the reasons set forth above with respect to the independent claims.

Based on the foregoing, all pending claims are allowable over the art of record.

Withdrawal of all rejections of under 35 U.S.C. § 103(a) are therefore respectfully requested.

Applicants believe that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Response is to be charged to Deposit Account No. 50-0388 (Order No. CISCP194).

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP



William J. Plut  
Limited Recognition under 37 C.F.R. § 10.9(b)

P.O. Box 70250  
Oakland, CA 94612-0250  
Telephone: (650) 961-8300